

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed August 28, 2003 ("*Office Action*"). Claims 1-52 were pending in the Application and stand rejected. Applicant amends Claims 1, 15, 24, 37, 42, and 46.

Claim Rejections - 35 U.S.C. §102(e)

The Examiner rejects Claims 1, 2, 5-7, 9, 12-16, 19-21, 23-25, 28-30, 32, 35-37, 39-43, 46, 47, 49, and 51 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,556,670 issued to Horn ("*Horn*"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131.

As amended, Claim 1 now recites "establishing an audio conference between a plurality of devices coupled to a packet network" and "wherein the media is communicated in packets." As amended, Claim 15 now recites "wherein the plurality of devices are coupled to the conference bridge using a packet network and the media is communicated in packets." As amended, Claim 24 now recites "establish an audio conference between a plurality of devices coupled to a packet network" and "wherein the media is communicated in packets." As amended, Claim 37 now recites "means for establishing an audio conference between a plurality of devices coupled to a packet network" and "wherein the media is communicated in packets." As amended, Claim 42 now recites "communicating media to a remote location using a packet network" and "wherein the media is communicated in packets." As amended, Claim 46 now recites "participating in an audio conference established by a conference bridge coupled to a packet network" and "wherein the media is communicated in packets."

The audio conference disclosed by *Horn* occurs on audio conference bridges in a circuit-switched network only. *See Horn*, Figure 1 and Col. 3, lines 31-50. The amended Claims, however, are directed to conferencing in a packet-based environment. Applicant therefore respectfully submits that *Horn* fails to teach, either expressly or inherently, every element of the amended Claims. Claims 2, 5-7, 9, 12-14, 16, 19-21, 23, 25, 28-30, 32, 35, 36, 39-41, 43, 47, 49, and 51 each depend from one of the amended Claims. Therefore,

4

Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 1, 2, 5-7, 9, 12-16, 19-21, 23-25, 28-30, 32, 35-37, 39-43, 46, 47, 49, and 51.

Claim Rejections - 35 U.S.C. §103(a)

For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 3, 4, 8, 10, 11, 17, 18, 22, 26, 27, 31, 33, 34, 38, 44, 45, 48, 50, and 52.

Claims 3, 4, 26, 27, 38, 44, 45, and 48

The Examiner rejects Claims 3, 4, 26, 27, 38, 44, 45, and 48 under 35 U.S.C. §103(a) as being unpatentable over *Horn* and further in view of an "Official Notice". These Claims each depend from one of the amended Claims discussed above that Applicant shows to be allowable. Thus, for this reason, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 3, 4, 26, 27, 38, 44, 45, and 48.

Furthermore, to the extent that the Examiner maintains this rejection based on "Official Notice," "well known prior art," "common knowledge," or other information within the Examiner's personal knowledge, Applicant respectfully requests that the Examiner cite a reference in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.104(d)(2).

Claims 8, 10, 11, 22, 31, 33, 34, 50, and 52

The Examiner rejects Claims 8, 10, 11, 22, 31, 33, 34, 50, and 52 under 35 U.S.C. 103(a) as being unpatentable over *Horn* and further in view of U.S. Patent No. 5,548,638 issued to Yamaguchi et al. ("*Yamaguchi*"). These Claims each depend from one of the amended Claims discussed above that Applicant shows to be allowable. Thus, for this reason, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 8, 10, 11, 22, 31, 33, 34, 50, and 52.

Furthermore, Applicant respectfully submits that *Horn* taken alone or in combination with *Yamaguchi* fails to teach or suggest all elements of Claim 22. To establish obviousness of a claimed invention under § 103, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974); M.P.E.P. § 2143.03.

Applicant's Claim 22 recites:

The conference bridge of Claim 15, further comprising a memory operable to store a plurality of conference entries, each



conference entry identifying the devices in the audio conference, a power measurement for each device, and a disable status of each device indicating whether media from the device is disabled.

The Examiner cites to *Horn*, Figure 3 and the Examiner's rejection of Claim 8. However, *Horn*, Figure 3 merely discloses a graphical user interface that allows a conferee to direct a conference bridge by pointing and clicking a mouse on a graphical representation. This does not teach or suggest "a plurality of conference entries, each conference entry identifying the devices in the audio conference, a power measurement for each device, and a disable status of each device indicating whether media from the device is disabled." The Examiner's reference to *Yamaguchi* in the rejection of Claim 8 also fails to teach or suggest this Claim. Therefore, for at least these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of Claim 22.

Claims 17 and 18

The Examiner rejects Claims 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over *Horn* and further in view of U.S. Patent No. 5,916,302 issued to Dunn et al. ("*Dunn*"). These Claims each depend from one of the amended Claims discussed above that Applicant shows to be allowable. Thus, for this reason, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 17 and 18.

Applicant also respectfully submits that the Examiner has employed improper hindsight reconstruction to combine *Horn* and *Dunn*. The Examiner has not shown a suggestion or a motivation in the references or in the knowledge generally available to one of ordinary skill in the art to combine the cited references, and speculation in hindsight that it would have been obvious to make a proposed combination because the proposed combination would be helpful is insufficient under governing Federal Circuit case law. See M.P.E.P. §2145 X.C. (stating that "[t]he Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.")

Moreover, Applicant respectfully submits that the proposed combination of *Horn* and *Dunn* would change the principle operation of the method and system disclosed by *Horn* and therefore is improper. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings

A

of the references are not sufficient to render the claims *prima facie* obvious.” M.P.E.P. §2143.01. The audio conference disclosed by *Horn* occurs on audio conference bridges in a circuit-switched network only. See *Horn*, Figure 1 and Col. 3, lines 31-50. *Dunn*, however, discloses a method to enable conference participants “to use external networks to vary services received in the PSTN during the conference.” *Dunn*, Col. 2, lines 22-24. Therefore, to combine the teachings of *Horn* and *Dunn*, an external network must be capable of controlling the services provided on the public switched telephone network (PSTN). However, transferring the audio conference disclosed by *Horn*, which occurs on a circuit-switched network, to an external network such as a packet network would require a substantial reconstruction and redesign of the elements disclosed in *Horn*. Thus, Applicant respectfully submits that the proposed combination of *Horn* and *Dunn* fails to render Claims 17 and 18 *prima facie* obvious.

Therefore, for at least these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of Claims 17 and 18.

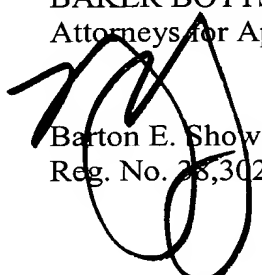
A

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any other fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants


Barton E. Showalter
Reg. No. 28,302

Address correspondence to:
2001 Ross Avenue
Dallas, Texas 75201-2980
Tel. 214.953.6509; Fax. 214.661.4509

Date: Nov. 25, 2003

A